

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated February 23, 2010 (hereinafter Office Action) have been considered. Claims 1, 3, 5-9, 13 and 15-30 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The Applicants first thank the Examiner for making note of the Office's inadvertent oversight in failing to address Claims 29 and 30 in the prior Office Action. This is an understandable oversight, and the Applicants thank the Examiner for making the present action a non-final Office Action as a result thereof.

The Applicants first note that it is believed that the claims prior to amendment are not rendered unpatentable by the cited prior art. However, in a good faith effort to move the case to allowance, the Applicants have amended claims in the present response. While the Applicants believe the amendments and remarks provided herein establish the patentability of the claimed invention, if the Examiner should disagree, the Applicants propose conducting an Examiner interview to address any remaining issues and ultimately expedite prosecution of the case.

Claims 1-3, 8-13, 19 and 21-30 are rejected based on 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0183062 by Kubosawa (hereinafter "*Kubosawa*") in view of WO 99/45733 to Halonen (hereinafter "*Halonen*"). The Applicants respectfully traverse the rejection.

Claim 1 is first addressed. It is first noted that the Examiner has identified item S9 and ¶0055 as describing the feature of Claim 1 involving checking the state of the user interface component automatically in response to detecting a need to initiate the handover algorithm. The Applicants respectfully disagree. Claim 1 indicates that the terminal may be set to an inactive state or to an active state, where the inactive state is the state of the user interface component when the user interface component is not being actively used. Thus, in Claim 1, checking the state of the user interface component involves automatically checking whether the user interface component is in the active state, or in the inactive state where the user interface component is not being actively used. This is not what *Kubosawa* is describing, either at the cited item S9 and ¶0055 or elsewhere. Rather, *Kubosawa* indicates that *Kubosawa* is monitoring "what the input by the user by using the input keys 62" is. (see *Kubosawa* ¶0055). Thus, it is respectfully

submitted that *Kubosawa* does not teach or suggest checking to determine whether a user interface component is in an active state, or in an inactive state where the user interface component is not being actively used.

Claim 1 also includes checking the state of the user interface component “automatically in response to detecting a need to initiate the handover algorithm.” On page 6, the Examiner identified *Kubosawa* as teaching this as, for example, ¶0033 and ¶0035, as well as figure 2, item S9. The Examiner suggests that *Kubosawa* describes at these cited paragraphs that a “handover is done by instructing the controller 50 by using input keys 62.” The Applicants respectfully disagree. The *Kubosawa* reference, and the Examiner’s own statements, make clear that any handover is in response to the user inputting something via input keys 62. If a user of *Kubosawa* is required to enter something via input keys 62, then the “checking” for anything is not an “automatic” response to detecting a need to initiate a handover algorithm. *Kubosawa* continually indicates that the user must designate something by way of the input keys, which is clearly not an automatic response to detecting a need to initiate a handover algorithm – rather, it is a response to a user entering something specific on a keypad.

It is additionally noted that Claim 1 includes checking the state of the user interface component in response to detecting a need to initiate the handover algorithm. *Kubosawa* merely discloses the specific identification of specific input keys to determine the user’s instruction whether to carry out a handover to another system in step S9. When there is no input in step S9 of *Kubosawa*, *Kubosawa* necessitates the handover algorithm to continue; communication quality is measured in step S5 to evaluate if a handover is required. Therefore, even if the Examiner’s interpretation that S9 is checking a user interface state in the manner claimed (which the Applicants disagree, as noted above), then *Kubosawa* clearly **teaches away** from Claim 1, as it discloses to continue the typical handover algorithm features also when there is no input from the user (e.g., return path from S9 to S3). Thus, this cannot read on automatically checking the state of the user interface component, as claimed, in response to detecting a need to initiate the handover algorithm.

Halonen does not remedy the deficiencies in this regard. *Halonen* does not describe or suggest any checking of a user interface component in response to a need to initiate handover or handover algorithm, but only indicates the possibility of preventing the handover algorithm by

stopping the time-limited handover algorithm based on elapsed time. Further, this handover algorithm of *Halonen* is not prevented based on detecting inactive user interface state, but rather on elapsed time (or possibly signal strength based on p. 3, lines 18-20). Thus the combination of *Kubosawa* and *Halonen* fails to disclose the current combination of features, or at least *Halonen* could not be combined with the cited procedure of *Kubosawa* (prevention of handover based on key input).

Nevertheless, in order to facilitate prosecution of the application, Claim 1 has been amended. Independent Claim 1 now includes initiating the handover algorithm in response to detecting the state of the user interface component to change from the inactive state to the active state. A combination of the cited references fails to disclose the initiation of the handover algorithm in response to detecting the user interface state to change from the inactive state to the active state. Rather, *Kubosawa* describes the contrary, to execute the inter-system handover in response to detecting in step S9 the user input and then ending the handover algorithm related procedure.

The combination of *Kubosawa* and *Halonen* fails to teach or suggest the features set forth in Claim 1, and therefore Claim 1 is in condition for allowance over the cited combination of references. Reconsideration and allowance of Claim 1 is respectfully solicited.

Independent Claims 9 and 21 were rejected on the same grounds as that of Claim 1. The arguments above made in connection with Claim 1 are also applicable to independent Claims 9 and 21, and therefore the *Kubosawa/Halonen* combination fails to establish a *prima facie* case of obviousness relative to Claims 9 and 21. Further, Claims 9 and 21 have been amended analogously to that of Claim 1, which further distinguishes Claims 9 and 21 from the *Kubosawa/Halonen* combination. For at least these reasons, Claims 9 and 21 are also in condition for allowance.

Dependent Claims 2 and 10-12 have been canceled without prejudice or disclaimer. Dependent Claims 3, 8, 22, 23 and 29, which are dependent from Claim 1, were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Kubosawa* and *Halonen*. Dependent Claims 13, 19, 24, 25, 28 and 30 which are dependent from Claim 9, were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Kubosawa* and *Halonen*. Dependent Claims 26 and 27, which are dependent from Claim 21, were also rejected

under 35 U.S.C. §103(a) as being unpatentable over the combination of *Kubosawa* and *Halonen*. While Applicants do not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 9 and 21. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 3, 8, 13, 19, 22, 23-30 are also allowable over the combination of *Kubosawa* and *Halonen*.

As noted above, these dependent claims include additional features beyond that of their respective independent claims that not taught or suggested by the cited combination of references. For example, Claims 23, 25 and 27 have been amended to indicate that radio measurements are omitted in response to the current state of the user interface component being inactive. Thus, these dependent claims specify omission of radio measurements during the inactive state, which is clearly not taught or suggested by *Kubosawa*, *Halonen*, or a combination thereof. For example, *Kubosawa* describes returning to step S3 in response to a lack of user input in step S9, and *Halonen* does not address this situation. For at least these additional reasons, amended Claims 23, 25 and 27 are in condition for allowance over the cited combination of references.

Claims 5, 15 and 16 are rejected based on 35 U.S.C. §103(a) as being unpatentable over *Kubosawa* in view of *Halonen* and further in view of U.S. Patent No. 6,178,388 to *Claxton* (hereinafter “*Claxton*”). The Applicants respectfully traverse the rejection. Claim 5 is dependent from independent Claim 1, and Claims 15-16 are dependent from independent Claim 9. As indicated above, the *Kubosawa/Halonen* combination at least does not teach or suggest the features set forth in independent Claims 1 and 9. *Claxton* does not remedy the deficiencies of the *Kubosawa/Halonen* combination, at least with respect to the features recited in independent Claims 1 and 9. Therefore, as *Claxton* does not describe such features of Claims 1 or 9, a combination of *Kubosawa*, *Halonen* and *Claxton* also fails to teach or suggest the limitations of

independent Claims 1 and 9, and therefore fails to teach or suggest the limitations of dependent Claims 5, 15 and 16. For at least these reasons, Claims 5, 15 and 16 are in condition for allowance. Further, the Applicants do not acquiesce that *Claxton* describes the *checking* of the states of the features set forth in Claims 5, 15 and 16.

Claims 6 and 17 are rejected based on 35 U.S.C. §103(a) as being unpatentable over *Kubosawa* in view of *Halonen* and further in view of U.S. Publication No. 2004/0204123 by *Cowsky III* et al. (hereinafter “*Cowsky III*”). The Applicants respectfully traverse the rejection. Claim 6 is dependent from independent Claim 1, and Claim 17 is dependent from independent Claim 9. As indicated above, the *Kubosawa/Halonen* combination at least does not teach or suggest the features set forth in independent Claims 1 and 9. *Cowsky III* does not remedy the deficiencies of the *Kubosawa/Halonen* combination, at least with respect to the features recited in independent Claims 1 and 9. Therefore, as *Cowsky III* does not describe such features of Claims 1 or 9, a combination of *Kubosawa*, *Halonen* and *Cowsky III* also fails to teach or suggest the limitations of independent Claims 1 and 9, and therefore fails to teach or suggest the limitations of dependent Claims 6 and 17. For at least these reasons, Claims 6 and 17 are in condition for allowance. Further, the Applicants do not acquiesce that *Claxton* describes the *checking* of any locking feature as set forth in Claims 6 and 17.

Claims 7 and 18 are rejected based on 35 U.S.C. §103(a) as being unpatentable over *Kubosawa*, *Halonen* and further in view of U.S. Publication No. 2004/0248594 by *Wren III* (hereinafter “*Wren III*”). The Applicants respectfully traverse the rejection. Claim 7 is dependent from independent Claim 1, and Claim 18 is dependent from independent Claim 9. As indicated above, the *Kubosawa/Halonen* combination at least does not teach or suggest the features set forth in independent Claims 1 and 9. *Wren III* does not remedy the deficiencies of the *Kubosawa/Halonen* combination, at least with respect to the features recited in independent Claims 1 and 9. Therefore, as *Wren III* does not describe such features of Claims 1 or 9, a combination of *Kubosawa*, *Halonen* and *Wren III* also fails to teach or suggest the limitations of independent Claims 1 and 9, and therefore fails to teach or suggest the limitations of dependent Claims 7 and 18. For at least these reasons, Claims 7 and 18 are in condition for allowance. Further, the Applicants do not acquiesce that *Wren III* describes the *detecting* of any such state as set forth in Claims 7 and 18.

Claim 20 is rejected based on 35 U.S.C. §103(a) as being unpatentable over *Kubosawa*, *Halonen* and further in view of U.S. Patent No. 6,871,074 to Harris et al. (hereinafter “*Harris*”). The Applicants respectfully traverse the rejection. Claim 20 is dependent from independent Claim 9. As indicated above, the *Kubosawa/Halonen* combination at least does not teach or suggest the features set forth in independent Claim 9. *Harris* does not remedy the deficiencies of the *Kubosawa/Halonen* combination, at least with respect to the features recited in independent Claim 9. Therefore, as *Harris* does not describe such features of Claim 9, a combination of *Kubosawa*, *Halonen* and *Harris* also fails to teach or suggest the limitations of independent Claim 9, and therefore fails to teach or suggest the limitations of dependent Claim 20. For at least these reasons, Claim 20 is in condition for allowance.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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